

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPH DORR

Appeal No. 1999-1876
Application No. 08/626,488

ON BRIEF

Before CALVERT, FRANKFORT, and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10 and 12 to 15. The other claims remaining in the application, 6 to 9, stand withdrawn from consideration under 37 CFR § 1.142(b) as being directed to a nonelected invention.

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The claims on appeal are drawn to a method for manufacturing a ball joint, and are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Jensen et al. (Jensen)	4,264,001	Apr. 28, 1981
Ueno et al. (Ueno)	5,352,059	Oct. 4, 1994
Donnellan et al. (Donnellan) (British Patent)	976,410	Nov. 25, 1964
Parker (British Patent)	1,121,004	Jul. 24, 1968
Kobayashi (Japanese Application)	52-032657	Aug. 23, 1977 ¹

The appealed claims stand finally rejected under 35 U.S.C. § 103(a) on the following grounds:

- (1) Claims 10, 12 and 15, unpatentable over Parker or Donnellan in view of Ueno;
- (2) Claim 13, unpatentable over Parker or Donnellan in view of Jensen;
- (3) Claim 14, unpatentable over Parker or Donnellan in view of Kobayashi.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 10 and 12 to 15 are rejected as being unpatentable for failure to comply with the

¹A translation of this reference, prepared for the USPTO, is enclosed herewith.

requirements of 35 U.S.C. § 112, second paragraph.

The test for definiteness under § 112, second paragraph, is whether those skilled in the art would understand the scope of the claims when the claims are read in light of the specification. Union Pacific Resources Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001); In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We do not consider that claims 10 and 12 to 15 meet this criterion, for the reasons stated below.

(a) Independent claims 10 and 15 both recite a method for manufacturing a ball joint "consisting of" a ball ended spindle and a socket. Since "consisting of" is a closed term, these claims would seem to be limited to manufacturing a ball ended spindle and a socket. However, each claim further recites that "a connection piece (3) or a complete chassis strut of said socket (29) is manufactured in said injection molding tool (1) simultaneously with said socket (29)" (claim 10, lines 12 to 14), or "simultaneously forming a connection piece of said socket in said injection molding tool" (claim 15, lines 15 and 16). These recitations that additional parts are manufactured or formed in the method are inconsistent with the recitation that the method is for manufacturing a ball joint "consisting of" a ball ended

spindle and socket, and due to this inconsistency, the scope of claims 10 and 12 to 15 is indefinite.

(b) Although claims 10 and 12 to 14 are drawn to a method, the scope of these claims is indefinite in that it is not clear what steps are being claimed, because rather than reciting a step of doing something, the claims state that something is done. For example, in claim 10, it is not clear whether, in reciting "is placed" in line 3, appellant intends to claim the step of "placing"; in line 7, whether "is retained" is intended to be a recitation of the step of "retaining"; and in line 13, whether "is manufactured" is intended to be a recitation of the step of "manufacturing." As further examples, in claim 13, it cannot be determined whether appellant intends to claim the step of welding, and in claim 14, whether "is provided" is a claimed step of the method. Claim 10 is also indefinite in its use of the expression "characterized in that" in line 6. It is not clear whether the subject matter recited prior to this expression is intended to be only the preamble of the claim, or is intended to include a step or steps of the claimed method.

Rejections Under 35 U.S.C. § 103(a)

It is well settled that a rejection under § 103 should not be based on considerable speculation as to the meaning of terms

in the claims and assumptions as to the scope of the claims, but rather, the claims should be rejected under § 112, second paragraph. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, in view of the rejection under § 112, second paragraph, made above pursuant to 37 CFR § 1.196(b), we will not sustain the rejections of claims 10 and 12 to 14 under § 103(a). We emphasize that we take this action pro forma, and that it should not be taken as an indication that if claims 10 and 12 to 14 were amended to overcome the rejection under § 112, they would necessarily be patentable under § 103(a) over the references applied by the examiner in the final rejection.

The § 103(a) rejection of claim 15 might well be treated in the same manner. However, in an effort to avoid piecemeal appellate review, we will for the purpose of this decision treat "consisting of" in line 2 of claim 15 as if it were --comprising --, and proceed to consider the § 103(a) rejection on that basis. Cf. Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984).

Parker, the first of the two primary references applied by the examiner, discloses a method of making a ball joint having a socket and a ball-ended spindle. The manner in which Parker's disclosure corresponds to the method recited in claim 15 is

described by the examiner on page 3 of the answer, and need not be repeated here.

The examiner finds that Parker does not teach "a complete chassis strut which is formed simultaneously/integrally with the socket," but concludes that it would have been obvious to form such a strut in view of Ueno (answer, pages 3 to 4). We note however, that claim 15 does not require forming a complete chassis strut, but only "simultaneously forming a connection piece of said socket in said injection molding tool." Since the portion of Parker's plastic socket 5 which covers the ring 3 and the neck portion of the steering rod 4 (to the right of ball 2 in Fig. 1) constitutes a "connection piece," as broadly recited, we consider that Parker meets all the limitations of claim 15.²

Moreover, assuming that Parker does not disclose forming a connection piece, as claimed, we agree with the examiner that it would have been obvious in view of Ueno to make a chassis strut (connection piece) simultaneously and integrally with the

²While this is tantamount to a conclusion that Parker anticipates claim 15 under § 102(b), it is an appropriate basis for sustaining the § 103(a) rejection since "The complete disclosure of an invention in the prior art is the ultimate or epitome of obviousness." In re Avery, 518 F.2d 1228, 1234, 186 USPQ 161, 166 (CCPA 1975).

socket.³ Ueno discloses in Fig. 11 and at col. 1, lines 25 to 34, that ball joints having synthetic resin seats 2 have been formed with metal sockets 3 and a metal rod 4 connecting the sockets, but that there are disadvantages to this arrangement (e.g., expense, weight) (col. 1, lines 35 to 41). As an alternative, Ueno teaches that these disadvantages may be overcome by forming the sockets and rod integrally, all out of synthetic resin (col. 1, line 47 et seq.). In view of this teaching, we conclude that one of ordinary skill would have been motivated to make the rod 4 of Parker out of plastic, integral with the socket 5, in order to gain the advantages taught by Ueno. Contrary to appellant's argument, this combination of the references would not be based on impermissible hindsight gleaned from appellant's disclosure, but upon the suggestion in the applied prior art of the desirability of making the combination.

Appellant also argues that if the teachings of Parker and Ueno were combined, the combination would lack essential features of the invention, because the ball-ended spindle would be pressed into the bearing socket (brief, pages 11 and 12). We disagree. Parker discloses molding a socket around the ball, not pressing

³The examiner also cited Ueno for its teaching of a groove, but a groove is not recited in claim 15.

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the ball into the socket, and modification of the Parker process in view of Ueno's teachings, discussed above, would result in a process in which the socket 5 was molded around the ball 2, and the socket, ring 3 and rod 4 were all molded as one integral piece of plastic, thereby meeting the method recited in claim 15.

For similar reasons, we consider the rejection of claim 15 as unpatentable over Donnellan in view of Ueno to be well taken. Appellant has made the same arguments with regard to this rejection (brief, pages 12 to 14) as with regard to the combination of Parker and Ueno, and they are equally unpersuasive.

Conclusion

The examiner's decision to reject claims 10 and 12 to 14 is reversed, pro forma. The examiner's decision to reject claim 15 is affirmed. Claims 10 and 12 to 15 are rejected pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53, 131, 53, 197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection

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shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b)
provides:

(b) Appellant may file a single request for rehearing
within two months from the date of the original
decision. . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN
TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of
the following two options with respect to the new ground of
rejection to avoid termination of proceedings (37 CFR § 1.197(c))
as to the rejected claims:

(1) Submit an appropriate amendment of the claims so
rejected or a showing of facts relating to the claims
so rejected, or both, and have the matter reconsidered
by the examiner, in which event the application will be
remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and Interferences
upon the same record. . . .

Should the appellant elect to prosecute further before the
Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to
preserve the right to seek review under 35 U.S.C. § 141 or 145
with respect to the affirmed rejection, the effective date of the
affirmance is deferred until conclusion of the prosecution before
the examiner unless, as a mere incident to the limited
prosecution, the affirmed rejection is overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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